REMARKS

Applicants submit this Reply in response to the Office Action mailed August 14, 2009. Claims 21-40 are currently pending, of which claims 21 and 37 are independent. No claims amendments are made herein.

In the Office Action, the Examiner objected to the specification under 37 C.F.R. 1.75(d)(1) for purportedly failing to provide antecedent basis for the subject matter recited in claim 40.[1] In addition, the Examiner rejected claims 21-28, 32, and 37-40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,522,888 ("Garceran"). The Examiner also rejected claims 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of U.S. Patent Publication No. 20040156372 ("Hussa"). Finally, claims 33-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of U.S. Patent Publication No. 20030125046 ("Riley"). Applicants respectfully traverse all pending objections and rejections and request reconsideration of the application.

Objection to the Specification

The specification stands objected to under 37 C.F.R. 1.75(d)(1) and M.P.E.P. § 608.01(o) for failing to provide antecedent basis for the claimed subject matter. In particular, regarding claim 40, the Examiner states that "applicant fails to mention or clearly describe or define the scope of a computer-readable medium and instructions stored thereon in the specification." Office Action, p. 4. In furtherance of this assertion, the Examiner cites page 12, lines 3-7 of the originally-filed specification, and using this

[1] The Office Action contains a number of statements characterizing Applicants' disclosure, including the claims, and the related art. Regardless of whether any such statement is specifically addressed herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

"complete sentence in the specification," notes that "the DB and the LM are separate components of the server, and thus the program code or software is not stored on the DB." Office Action, p. 3. The Examiner then reasons that "the above sentence did not mention or states [sic] that the database (computer-readable medium) stores program codes (instructions)," *id.*, to maintain the objection to the specification.

Applicants respectfully disagree with the Examiner's characterization of the issues. Applicants do not contend that the database constitutes the claimed computer-readable medium. Instead, Applicants contend that page 12, lines 5-7 of the originally-filed specification provides support for the claimed "computer-readable medium storing instructions" through its express, implicit, or inherent disclosure that the server comprises a computer-readable medium that stores instructions in the form of the locating module's program code, which, when executed by the server, performs terminal location.

Expanding on the remarks included in the Amendment filed on July 21, 2009, Applicants note that although "newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure," "there is no *in haec verba* requirement . . . ." M.P.E.P. § 2163(I) (8th ed., rev. 7, July 2008). Applicants therefore submit that page 12, lines 5-7 of the originally-filed specification expressly, implicitly, and/or inherently describes the "computer-readable medium storing instructions for execution by a processing system, the instructions comprising one or more code modules that when executed by the processing system perform a method for locating a terminal," as required by claim 40. Page 12, lines 5-7 of the originally-filed specification states that the server comprises "a locating engine or module LM including different

algorithms as program codes that can be executed on the server to perform the terminal position computation." (emphasis added).

In short, this portion of the specification makes clear that the locating module comprises program code that is executed on the server, which necessarily comprises a computer-readable medium, to compute a terminal's position. Therefore, Applicants respectfully request withdrawal of the objection to the specification.

Rejections Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 21-28, 32, and 37-40 under 35 U.S.C. § 102(e) as being anticipated by Garceran. To establish anticipation under §102(e), the Examiner must show that Garceran discloses every element of the Applicants' claims, either expressly or inherently. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Furthermore, the identical disclosure "must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In this case, Garceran fails to teach or suggest every element of Applicants' claimed invention.

Independent claim 21 recites, among other things, "[a] method for locating a terminal . . . performed at a locating system that provides a location estimation of the terminal . . . wherein . . . the locating system is located remotely from the terminal and the plurality of base stations." Independent claim 37 recites, among other things, "[a] processing system for locating a terminal . . . by providing a location estimation of the terminal, wherein . . . the processing system is located remotely from the terminal and

the plurality of base stations." Garceran fails to teach or suggest at least these elements of Applicants' independent claims 21 and 37.

As Applicants have explained in previous Amendments, Garceran generally discloses a system in which the location of a wireless unit is determined by the wireless unit or a base station and is then transmitted to either the base station or an RF database, respectively. *See, e.g.*, Amendment filed July 21, 2009, p. 11; Amendment filed February 12, 2009, pp. 14-15. In an embodiment where the wireless unit determines its own location, Garceran discloses that the wireless unit "includes GPS receiver circuitry 72 which receives GPS signals." Garceran, col. 6, ll. 35-36. Garceran further discloses that, "[t]hrough interaction with a GPS system of satellites and control centers . . . the GPS receiver circuitry 72 provides a location information which can include time, speed, distance, and/or direction for the wireless unit to the processing circuitry 78 of the wireless unit." *Id.* at col. 6, ll. 39-44. The processing circuitry then "manipulate[s] the location information into an appropriate format and store[s] . . . the location information in a . . . memory. For example, the location information can be stored . . . as the latitude and longitude coordinates [of the wireless unit]." *Id.* at col. 6, ll. 49-53.

In rejecting independent claims 21 and 37, the Examiner appears to equate Garceran's disclosure of a GPS satellite system to the "locating system" recited by claim 21 and to the "processing system" recited by claim 37 because the GPS satellite system is located remotely from the terminal and base stations. *See* Office Action, p. 3; p. 4; p. 7. This reasoning is incorrect. As shown above, instead of disclosing that the GPS satellite system provides location information or manipulates this information to obtain

the latitude and longitude coordinates of the wireless unit, Garceran discloses that these functions are performed by the wireless unit's GPS receiver circuitry and its processing unit, respectively. *See* Garceran, col. 6, ll. 35-53. Accordingly, even if the GPS satellite system of Garceran is located remotely from the terminal and the base stations, it cannot constitute the "locating system" of claim 21, because it does not "provide a location estimation of the terminal," as required by independent claim 21. Nor can the GPS satellite system of Garceran constitute the "processing system" of claim 37 because claim 37 also requires that the "processing system . . . provid[es] a location estimation of the terminal."

Accordingly, Garceran does not teach or suggest "[a] method for locating a terminal . . . performed at a locating system that provides a location estimation . . . wherein . . . the locating system is located remotely from the terminal and the plurality of base stations," as recited by independent claim 21. Nor does it teach or suggest "[a] processing system for locating a terminal . . . by providing a location estimation of the terminal, wherein . . . the processing system is located remotely from the terminal and the plurality of base stations," as recited by independent claim 37. Because Garceran does not disclose every element of claims 21 and 37, it cannot anticipate these claims. Claims 22-28, 32, and 38-40 depend from one of amended independent claims 21 and 37, and are therefore allowable for at least the same reasons. Thus, Applicants respectfully request the withdrawal of the rejection of claims 21-28, 32 and 37-40 under 35 U.S.C. § 102(e).

Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Hussa and the rejection of claims 33-36 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Riley. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See* M.P.E.P. § 2142. In this application, a *prima facie* case of obviousness has not been established because the scope and content of the prior art have not been properly ascertained, *see* M.P.E.P. § 2141, and thus, a reason why the prior art would render obvious the claims has not been articulated.

Applicants have already established that Garceran does not teach or suggest at least "[a] method for locating a terminal . . . performed at a locating system that provides a location estimation of the terminal . . . wherein . . . the locating system is located remotely from the terminal and the plurality of base stations," as recited by independent claim 21, and as required by each of dependent claims 29-31 and 33-36. Moreover, the Office Action's application of Hussa and Riley fails to cure the above-noted deficiencies of Garceran.

More particularly, the Office Action alleges that

> Hussa teaches transferring, to the terminal of the network (mobile based positioning), . . . , processing programs for performing at least one subset of locating procedures . . . , and at least one subset of said plurality of configuration data base entries (base station coordinates) used by the transferred locating procedures . . . , whereby the location estimation is performed by the terminal and information about estimated position and

> estimation accuracy are transmitted from the terminal to a locating system upon every service request.

Office Action, p. 9 (internal citations omitted). The Office Action further alleges that "Hussa teaches the terminal performing signal measurement and calculates the location estimation." *Id.* at p. 10.

Regarding Riley, the Office Action alleges that "Riley teaches estimates [sic] the position of the terminal corresponding to the barycenter (centroid) coordinates of the coverage area of said base station and an uncertainty value, the uncertainty value being defined by the distances from said barycenter to all points of the coverage area." *Id.* at p 11 (internal citations omitted).

Even assuming that the Office Action's characterizations of Hussa and Riley are correct, which Applicants do not concede, neither Hussa nor Riley teach or suggest the above-noted claim feature of independent claim 21, which is required by each of dependent claims 29-31 and 33-36. Accordingly, the cited references, taken either alone or in any reasonable combination, fail to teach or suggest all the recitations of claims 29-31 and 33-36. Thus, the Office Action has not articulated a reason why the claims would have been obvious to one of ordinary skill in the art and no *prima facie* case of obviousness has been established with respect to claims 29-31 and 33-36.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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